

ESTTA Tracking number: **ESTTA310213**

Filing date: **10/07/2009**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Hearst Communications, Inc.
Granted to Date of previous extension	11/11/2009
Address	300 West 57th StreetOGC New York, NY 10019 UNITED STATES
Attorney information	Bridgette Fitzpatrick Hearst Communications, Inc. 300 West 57th Street, Office of the General Counsel New York, NY 10019 UNITED STATES bfitzpatrick@hearst.com, sfavitta@hearst.com Phone:212-649-2059

Applicant Information

Application No	77263841	Publication date	07/14/2009
Opposition Filing Date	10/07/2009	Opposition Period Ends	11/11/2009
Applicant	Cosmogateway Inc 5090 Richmond Ave #150 Houston, TX 77056 UNITED STATES		

Goods/Services Affected by Opposition

<p>Class 009.</p> <p>All goods and services in the class are opposed, namely: Electronic publications, downloadable via world wide web, namely, electronic books, textbooks, periodicals, sound and video recordings in the fields of arts, economics, business, education, math, sciences, literature, history and culture; computer software for use in creating online educational and learning environments and for creating web-based educational computer applications; computer software in the form of a database for use in the field of knowledge management in business, science and engineering</p>
<p>Class 041.</p> <p>All goods and services in the class are opposed, namely: Providing online and web-based educational services, namely, design and delivery of online courses in the fields of arts, economics, business, education, math, sciences, literature, history and culture; Publication of educational textbooks, books, guides and manuals; Publication of educational textbooks, books, guides and manuals on CD-ROM and DVD-ROM; Electronic online publishing services, namely, nondownloadable online electronic publication of educational textbooks, books, guides, manuals, test banks, multimedia resource kits; providing online educational study tools, namely, tutorials, study exercises and answers, interactive workbooks, interactive lab activities in the fields of arts, economics, business, math, sciences, literature, history and culture; Providing educational services, namely, courses, seminars, conferences and workshops in the field of knowledge management in</p>

business, science and engineering

Grounds for Opposition

Deceptiveness	Trademark Act section 2(a)
False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)


Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	630028	Application Date	08/10/1955
Registration Date	07/03/1956	Foreign Priority Date	NONE
Word Mark	COSMOPOLITAN		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class U038 (International Class 016). First use: First Use: 1886/03/00 First Use In Commerce: 1886/03/00 MAGAZINE OR PERIODICAL PUBLISHED MONTHLY OR AT OTHER INTERVALS		

U.S. Registration No.	1911389	Application Date	08/31/1994
Registration Date	08/15/1995	Foreign Priority Date	NONE
Word Mark	COSMOPOLITAN		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 016. First use: First Use: 1994/07/01 First Use In Commerce: 1994/07/01 books of general interest		

U.S. Registration No.	2518660	Application Date	01/20/1999
Registration Date	12/11/2001	Foreign Priority Date	NONE
Word Mark	COSMOPOLITAN.COM		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 1997/11/00 First Use In Commerce: 1997/11/00 COMPUTER SERVICES, NAMELY PROVIDING AN INTERACTIVE ON-LINE COMPUTER DATABASE FEATURING PORTIONS OF VARIOUS MAGAZINES AND ARTICLES AND ILLUSTRATIVE MATERIALS IN THE FIELDS OF PERSONAL RELATIONSHIPS, BEAUTY AND FASHION, HEALTH AND FITNESS, PERSONAL HYGIENE, STARS AND ENTERTAINMENT NEWS, AND LIFE AND WORK, RENDERED BY MEANS OF A GLOBAL COMPUTER NETWORK		

U.S. Registration No.	2527954	Application Date	01/20/1999
Registration Date	01/08/2002	Foreign Priority Date	NONE
Word Mark	COSMO GIRL		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 016. First use: First Use: 1999/06/29 First Use In Commerce: 1999/06/29 general interest magazine for girls and young women		


U.S. Registration No.	2407134	Application Date	01/20/1999
Registration Date	11/21/2000	Foreign Priority Date	NONE
Word Mark	COSMO GIRL!		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 1999/06/29 First Use In Commerce: 1999/06/29 Providing an interactive on-line computer database featuring portions of various magazines and articles and illustrative materials in the fields of personal relationships, beauty and fashion, health and fitness, personal hygiene, stars and entertainment news and life and work, rendered by means of a global computer network		

U.S. Registration No.	3372644	Application Date	06/01/2007
Registration Date	01/22/2008	Foreign Priority Date	NONE
Word Mark	COSMO		
Design Mark			

Description of Mark	NONE
Goods/Services	Class 016. First use: First Use: 2007/05/08 First Use In Commerce: 2007/05/08 Magazines featuring information on women's services, beauty, health, and human relationships

U.S. Application No.	77137373	Application Date	03/22/2007
Registration Date	NONE	Foreign Priority Date	NONE

Word Mark	COSMO
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Design Mark	
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Description of Mark	NONE
Goods/Services	Class 041. First use: First Use: 2002/03/29 First Use In Commerce: 2002/03/29 PUBLICATION OF ELECTRONIC MAGAZINE PORTIONS AND PUBLICATION OF ELECTRONIC MAGAZINE ARTICLES AND ILLUSTRATIVE MATERIALS IN THE FIELDS OF PERSONAL RELATIONSHIPS, BEAUTY AND FASHION, HEALTH AND FITNESS, AND PERSONAL HYGENE

Attachments	75623902#TMSN.gif (1 page)(bytes) 77195652#TMSN.jpeg (1 page)(bytes) 77137373#TMSN.jpeg (1 page)(bytes) Not of Opp cosmogateway class 9.pdf (9 pages)(302062 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Bridgette Fitzpatrick/
Name	Bridgette Fitzpatrick
Date	10/07/2009

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

HEARST COMMUNICATIONS, INC.,)	
)	In re Serial No. 77/263,841
Opposer,)	
)	
)	Mark: COSMOGATEWAY
)	
v.)	
)	Opposition No. _____
Cosmogateway Inc.)	
)	
Applicant.)	
_____)	

NOTICE OF OPPOSITION

Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22314

Commissioner:

Opposer Hearst Communications, Inc. will be damaged by the registration of the COSMOGATEWAY mark Application Serial No. 77/263,841 and states the following for its Notice of Opposition:

1. Opposer Hearst Communications, Inc. ("HCI") is a Delaware corporation with a principal place of business at 300 West 57th Street, New York, New York 10019. HCI is a subsidiary of The Hearst Corporation, one of the world's largest diversified media companies. Among its other activities, HCI is a publisher of magazines and other printed materials and a provider of online content.

2. Beginning in 1886, more than a century prior to the August 24, 2007 filing date of Applicant's intent-to-use application, HCI's predecessors-in-interest began using the COSMOPOLITAN mark in connection with a magazine.

3. For more than 120 years, HCI and its predecessors have invested a substantial amount of time, effort, and money in promoting the internationally famous and well-known COSMOPOLITAN magazine. COSMOPOLITAN magazine has consistently been one of the top 20 selling magazines in the United States and one of the top 5 selling women's magazines. COSMOPOLITAN magazine has a monthly paid circulation of over 2,900,000 and an estimated readership in the United States of over 15,000,000. It has 58 international editions, is published in 36 languages and is distributed in more than 100 countries, making it the largest monthly magazine franchise in the world.

4. HCI's COSMOPOLITAN mark is subject to Registration Nos. (i) 630,028, with a priority date at least as early as March 1886 and issued July 3, 1956, for a "magazine or periodical published monthly or at intervals" in International Class 16 (this registration is incontestable); (ii) 1,911,389, with a priority date at least as early as July 1994 and issued August 15, 1995, for "books of general interest" in International Class 16 (this registration is incontestable).

5. Since 1996, more than a decade prior to the filing date of Applicant's August 24, 2007 intent-to-use application, HCI has been distributing its copyrighted magazine content, including the content contained in COSMOPOLITAN magazine, via the popular web site www.cosmopolitan.com.

6. HCI's COSMOPOLITAN.COM mark is subject to Registration No. 2,518,660, with a priority date at least as early as November 1997 and issued December 11, 2001 (this registration is incontestable), for "computer services, namely interactive on-line computer database featuring portions of various magazines and articles and illustrative materials in the fields of personal relationships, beauty and fashion, health and fitness, personal hygiene, stars

and entertainment news and life and work, rendered by means of a global computer network” in International Class 42.

7. Since 1999, almost a decade prior to the filing date of Applicant’s August 24, 2007 intent-to- use application, HCI began use of the COSMO GIRL mark in connection with a magazine for teens and younger women that also feature articles on “lifestyle” subjects. Like its sister magazine, COSMOPOLITAN, COSMO GIRL magazine became famous and well-known. COSMO GIRL is currently published online at www.cosmogirl.com.

8. HCI’s COSMO GIRL mark is subject of Registration Nos. (i) 2,527,954, with a priority date at least as early as June 1999 and issued January 8, 2002 (this registration is incontestable), for “general interest magazine for girls and young women” in International Class 16; and (ii) 2,407,134, with a priority date at least as early as June 1999 and issued November 21, 2000, for “providing an interactive on-line computer database featuring portions of various magazines and articles and illustrative materials in the fields of personal relationships, beauty and fashion, health and fitness, personal hygiene, stars and entertainment news and life and work, rendered by means of a global computer network” in Class 42.

9. References to HCI’s COSMOPOLITAN mark are often abbreviated by HCI and by the public as COSMO. Since 1964, more than 30 years prior to the filing date of Applicant’s August 24, 2007 intent-to- use application, HCI has used and, in most cases, obtained registrations for titles and magazine sections such as COSMOLICIOUS, COSMO HAIR, COSMO GYNO, COSMO MOBILE, COSMO KISSES, COSMO COMMANDMENTS, COSMO QUIZ, COSMO WEEKEND, COSMO FAQs, COSMO BEAUTY, COSMO KAMA SUTRA, COSMO FASHION, CONNECT WITH COSMO, BE IN COSMO, COSMO EXCLUSIVES, COSMO FOR YOUR GUY, GET COSMO HEADLINES, MAKE COSMO

YOUR HOMEPAGE, TELL COSMO ABOUT YOUR HAIR!, HELP COSMO CHOOSE ITS COVERLINES, MAKE A GREAT RECIPE FROM COSMO RADIO, THE SPORTING A STYLE YOU FOUND IN COSMO?, ADD COSMO TO YOUR MYSPACE, GET COSMO UPDATES, COSMO RADIO, COSMO PROMO HOT SPOT, and COSMO POST, in connection with its magazines and online publications. As a result of this widespread and widely promoted use, the public has come to associate marks featuring “COSMO” with HCI.

10. HCI’s COSMO mark is subject of Registration Nos. (i) 3,372,644, with a priority date at least as early as May 2007 and issued January 22, 2008, for “Magazines featuring information on women's services, beauty, health, and human relationships” in International Class 16; and subject to Pending Application No. 77/137,373, with a priority date at least as early as March 2002, for “publication of electronic magazine portions and publication of electronic magazine articles and illustrative materials in the fields of personal relationships, beauty and fashion, health and fitness, and personal hygiene” in International Class 41.

11. As part of its licensing program for the COSMO and COSMOPOLITAN marks, HCI has licensed use of the COSMO and COSMOPOLITAN marks in connection with a variety of goods and services.

12. Taken together, HCI’s marks based on the elements COSMO, COSMO GIRL and COSMOPOLITAN constitute a family of marks. Beginning over a hundred and twenty years ago, HCI and its predecessors have expended considerable sums of money into developing consumer brand recognition for its family of COSMO, COSMO GIRL and COSMOPOLITAN marks.

13. As a result of widespread advertising and promotion by HCI and its predecessors, the marks making up HCI’s family of COSMO, COSMO GIRL and COSMOPOLITAN marks

acquired a high degree of recognition, fame, and distinctiveness as symbols of the high quality products and services offered by HCI prior to the August 24, 2007 filing date of Applicant's application. The public and trade are familiar with and identify HCI's marks with HCI and, by reason of this identification, goods and services associated with the marks are understood by the public and trade to be produced, marketed, and supplied under HCI's authority, or otherwise derived from HCI.

14. The marks making up HCI's family of COSMO, COSMO GIRL and COSMOPOLITAN marks are important factors employed by the public in identifying the source of HCI's products and services and are distinctive of those products and services. As a result of their fame and notoriety, HCI's marks are entitled to a broad scope of protection.

15. Applicant's COSMOGATEWAY mark fully incorporates the dominant COSMO term and is likely, when use in connection with Applicant's goods/services, namely, "Electronic publications, downloadable via world wide web, namely, electronic books, textbooks, periodicals, sound and video recordings in the fields of arts, economics, business, education, math, sciences, literature, history and culture; computer software for use in creating online educational and learning environments and for creating web-based educational computer applications; computer software in the form of a database for use in the field of knowledge management in business, science and engineering" in International Class 9; and "Providing online and web-based educational services, namely, design and delivery of online courses in the fields of arts, economics, business, education, math, sciences, literature, history and culture; Publication of educational textbooks, books, guides and manuals; Publication of educational textbooks, books, guides and manuals on CD-ROM and DVD-ROM; Electronic online publishing services, namely, nondownloadable online electronic publication of educational

textbooks, books, guides, manuals, test banks, multimedia resource kits; providing online educational study tools, namely, tutorials, study exercises and answers, interactive workbooks, interactive lab activities in the fields of arts, economics, business, math, sciences, literature, history and culture; Providing educational services, namely, courses, seminars, conferences and workshops in the field of knowledge management in business, science and engineering” in International Class 41, to cause confusion or mistake or deceive purchasers as to the source of the goods/services, thereby, resulting in damage and detriment to HCI and its reputation.

16. When taken as a whole, Applicant’s mark is substantially similar to the salient element of HCI’s COSMO, COSMO GIRL AND COSMOPOLITAN marks, and will be used for goods and services that are identical to the goods and services for which HCI uses its family of COSMO, COSMO GIRL and COSMOPOLITAN marks.

17. Based on the similarities of the marks and the goods/services, namely, “electronic publications, downloadable via world wide web, namely, electronic books, textbooks, periodicals, sound and video recordings in the fields of arts, economics, business, education, math, sciences, literature, history and culture; computer software for use in creating online educational and learning environments and for creating web-based educational computer applications; computer software in the form of a database for use in the field of knowledge management in business, science and engineering” in International Class 9; and “Providing online and web-based educational services, namely, design and delivery of online courses in the fields of arts, economics, business, education, math, sciences, literature, history and culture; Publication of educational textbooks, books, guides and manuals; Publication of educational textbooks, books, guides and manuals on CD-ROM and DVD-ROM; Electronic online publishing services, namely, nondownloadable online electronic publication of educational

textbooks, books, guides, manuals, test banks, multimedia resource kits; providing online educational study tools, namely, tutorials, study exercises and answers, interactive workbooks, interactive lab activities in the fields of arts, economics, business, math, sciences, literature, history and culture; Providing educational services, namely, courses, seminars, conferences and workshops in the field of knowledge management in business, science and engineering” in International Class 41, the relevant public is likely to be confused into believing that Applicant’s goods/services, as offered under the COSMOGATEWAY, emanate from HCI, or are authorized, licensed, endorsed, or sponsored by HCI. Registration of Applicant’s mark on the Principal Register thus would be inconsistent with HCI’s prior rights in its family of well-known COSMO, COSMO GIRL and COSMOPOLITAN marks.

18. HCI will be damaged by the registration of Applicant’s COSMOGATEWAY mark because it so resembles HCI’s previously used and well-known marks as to be likely, when used on or in connection with Applicant’s Goods/Services identified in the subject application, to cause confusion, or to cause mistake, or to deceive in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052.

19. HCI will be damaged by the registration of Applicant’s COSMOGATEWAY mark because the mark is likely to dilute the distinctiveness of the famous marks making up HCI’s family of COSMO, COSMO GIRL and COSMOPOLITAN marks by eroding consumers’ exclusive identification of these marks with HCI, and/or by otherwise lessening the capacity of the marks to identify and distinguish HCI’s goods and services in violation of Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c).

20. HCI therefore requests that registration of the mark underlying Application Serial No. 77/263,841 be refused, and this Notice of Opposition be sustained in HCI's favor.

This 7th day of October, 2009.

Respectfully submitted,


Bridgette Fitzpatrick

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Attorney for Opposer

CERTIFICATE OF SERVICE

This is to certify that the attached Notice of Opposition has been served upon Applicant's counsel by depositing a copy in the United States mail as first class mail, postage pre-paid, addressed as follows:

COSMOGATEWAY Inc.
Attn: Ms. Irina Mullins, President
5090 Richmond Ave 3150
Houston, TX 77056

This 7th day of October, 2009.


Bridgette Fitzpatrick